

REMARKS

Claims 1-28 are pending in this application. Reconsideration and withdrawal of the rejections set forth in the Official Action are respectfully requested in view of this amendment and the following reasons. Claims 1, 17, 18, 25, and 26 have been amended to replace the phrase "blister-like vesicles mounted on a first surface" with -- blister-like vesicles including a convex surface protruding above a first surface --. Support for this amendment may be found at least in Figs. 1 and 2 of the present application as originally filed. It is respectfully submitted that this amendment introduces no new matter within the meaning of 35 U.S.C. §132.

Entry of the Amendment is proper under 37 C.F.R. §1.116 because it (a) places the application in *prima facie* condition for allowance for the reasons discussed herein; (b) does not raise new issues requiring further search and/or consideration by the Examiner because similar subject matter was previously considered by the Examiner and thus further consideration and/or search by the Examiner is not warranted; and (c) places the application in better form for appeal, should an appeal be necessary. For at least these reasons, entry of the present Amendment is therefore respectfully requested. Accordingly, Applicants request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Rejections Under 35 U.S.C. §103

1. Claims 1-6 and 12-16 stand rejected under 35 U.S.C. §103(a) as being allegedly

unpatentable over International Patent Application Publication WO 02/30401 applied for by Sheppard, *et al.* ("Sheppard") in view of U.S. Patent No. 6,669,683 issued to Santini, Jr., *et al.* ("Santini").

To establish an obviousness rejection under 35 U.S.C. § 103(a), four factual inquiries must be examined. The four factual inquiries include (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966). In view of these four factors, the analysis supporting a rejection under 35 U.S.C. 103(a) should be made explicit, and should "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Furthermore, even if the prior art may be combined, there must be a reasonable expectation of success, and the reference or references, when combined, must disclose or suggest all of the claim limitations. See *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Assuming *arguendo* that the references may be combined and a reasonable expectation of success exists, the combined references do not disclose or suggest all of the claim features. Claim 1, as amended, recites, *inter alia*:

a plurality of blister-like vesicles *including a convex surface protruding above a first surface*, each vesicle having at least a metallic portion formed from a first metal, and each vesicle having a wall surrounding a lumen, which is configured to be filled with the one or more substances that are to be released into the body cavity;

for each vesicle, an *individual electrical connection between the metallic portion of the vesicle and the first terminal of the power supply*, each connection including a switch so as to allow the metallic portion to function as an anode when the switch is closed; ... (emphasis added)

The Examiner asserts that, in Sheppard, the reservoir 58 lying on top of the surface of the microchip device 52 and the cap 60 lying on top of the reservoir 58 together form a protrusion above the surface of the microchip device 52 (Official Action, page 2, last line – page 3, line 5). By this amendment, the phrase “a plurality of blister-like vesicles mounted on a first surface” has been replaced with -- a plurality of blister-like vesicles including a convex surface protruding above a first surface --. This amended feature may be supported by, for example, Figs. 1 and 2 of the present application wherein the plurality of blisters 105, 205 include a convex surface 115, 215 protruding above either a flat surface (Fig. 1) or a cylindrical surface (Fig. 2). Sheppard fails to teach this claim feature because the arrangement shown in Fig. 2 of Sheppard does not show any “convex surface” protruding above the surface of the microchip device 52, which allegedly teaches the “first surface” recited in claim 1. Thus, it is clear that Sheppard does not teach or suggest “a plurality of blister-like vesicles including a convex surface protruding above a first surface, each vesicle having at least a metallic portion formed from a first metal, and each vesicle having a wall surrounding a lumen, which is configured to be filled with the one or more substances that are to be released into the body cavity,” as recited in claim 1.

The secondary reference, Santini, is cited in an attempt to cure the Examiner-

admitted deficiencies of Sheppard, i.e., lack of disclosure of "for each vesicle, an individual electrical connection between the metallic portion of the vesicle and the first terminal of the power supply, each connection including a switch so as to allow the metallic portion to function as an anode when the switch is closed" recited in claim 1. However, Santini also fails to teach "a plurality of blister-like vesicles including a convex surface protruding above a first surface, each vesicle having at least a metallic portion formed from a first metal, and each vesicle having a wall surrounding a lumen, which is configured to be filled with the one or more substances that are to be released into the body cavity," as recited in claim 1. Thus, even if one of ordinary skill in the art happens to combine the teachings of Sheppard and Santini, this combination still does not teach each and every feature recited in claim 1. Accordingly, Applicants respectfully submit that claim 1 is allowable over Sheppard and Santini whether taken alone or in combination. Claims 2-6 and 12-16 depend from claim 1, and thus are allowable for at least this reason.

2. Claims 7-11 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sheppard in view of Santini, and in further view of U.S. Patent No. 6,293,923 issued to Yachia, *et al.* ("Yachia").

Claims 7-11 depend from claim 1. Yachia is cited by the Examiner in an attempt to teach the additional features of the dependent claims, but fails to cure the deficiencies of Sheppard and Santini as noted above with regard to claim 1. Hence, even if one of ordinary skill in the art happens to combine the teachings of Sheppard, Santini, and

Yachia, this combination still does not teach all of the features recited in claim 1. Accordingly, Applicants respectfully submit that claims 7-11 are allowable over the references because they depend from allowable claim 1.

3. Claims 17-24 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sheppard in view of Santini, and in further view of Yachia.

Claims 17 and 18 are directed to a system for treating a body cavity of an individual, reciting similar features as those of claim 1 recited above, and thus are allowable over the same references, i.e., Sheppard, Santini, and Yachia. Claims 19-24 depend from claim 18, and thus are allowable for at least this reason.

4. Claims 25-28 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Sheppard in view of Santini, and in further view of Yachia.

Claims 25 and 26 are directed to a method for releasing one or more substances into a body cavity containing an electrolyte fluid of an individual, reciting similar features as those of claim 1 recited above, and thus are allowable over the same references, i.e., Sheppard, Santini, and Yachia. Claims 27 and 28 depend from claim 25, and thus are allowable for at least this reason.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1-28. Since none of the other prior art of record, whether taken alone or

in any combination, discloses or suggests all the features of the claimed subject matter, Applicants respectfully submit that independent claims 1, 17, 18, 25, and 26, and all the claims that depend therefrom, are allowable.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Official Action and respectfully submit that all of the stated grounds for rejection have been overcome or rendered moot. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative at the number below to expedite prosecution.

If an extension of time is necessary to prevent abandonment of this application and is not filed herewith, then such extension of time is hereby petitioned for under 37 C.F.R. §1.136(a). Any fees required for further extensions of time and any fees for the net addition of claims are hereby authorized to be charged to our Deposit Account No. 14-0112. Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,
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January 19, 2010

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